

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 1-12 are all the claims pending in the application. Claims 6-12 are withdrawn from consideration. In response to the Office Action, Applicant respectfully submits that the claims define patentable subject matter.

I. Overview of the Office Action

Applicant thanks the Examiner for withdrawing the previous rejections based on Kuzma (U.S. Patent No. 5,771,289). Claims 1-5 are now rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 1-5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuzma in view of Mobile Tech News, “Logica first to enable MMS Intercarrier Messaging”, hereafter “Mobile News”. Applicant respectfully traverses the rejections.

II. Rejection of claims 1-5 under 35 U.S.C. § 101

Claims 1-5 stand rejected under 35 USC §101 because they are allegedly directed to non-statutory subject matter. The Examiner argues that “[t]he cited claims can be interpreted as purely software per se and thus the cited claims fail to fall into the statutory class of an article of manufacture.”² However, Applicant respectfully disagrees with the Examiner’s position, and respectfully submits that the statutory requirements of 35 U.S.C. § 101 have been met for at least the following reasons.

² Page 3 of the Office Action dated July 28, 2008

First, Applicant respectfully disagrees with the Examiner's stated position that the claims can be interpreted as purely software. The invention proposes a method of sending a message in a multimedia message service environment wherein a sent Multimedia Messaging Service message includes an electronic stamp whose validity is verified by the multimedia message service center. The MMS message is sent from a sender terminal, and the sender terminal submits a request, accompanied with payment, to a stamp provider which supplies a stamp in the form of an encrypted numerical value. Applicant thus respectfully submits that the claims cannot be interpreted as "purely software" as asserted by the Examiner

Second, it is well established that in order to satisfy the requirements of 35 U.S.C. § 101, a claimed invention must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. In the instant application, a message is sent in a multimedia message service environment wherein a sent Multimedia Messaging Service message includes an electronic stamp whose validity is verified by a multimedia message service center. The payment for the multimedia message is a "tangible result" of the claimed invention.

Further, the "usefulness" of the invention is established by its ability to eliminate the need for a user of a terminal to have to establish an account with a particular service provider for billing purposes when the user sends multimedia messages. This reduces the burden on users and prevents a slowing of the expansion of multimedia service communication from the Internet to mobile terminals. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 101 rejection is erroneous, and respectfully requests that the Examiner remove this rejection.

Third, Applicants disagrees with the Examiner's assertion that the claims do not fall into the statutory class of an article of manufacture. However, even if the claims do not fall into the statutory class of an article of manufacture, the claims cannot be rejected only on this basis, since an article of manufacture is not the only statutory class.

The Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106) state that "any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent." The Guidelines note that the courts have developed three exceptions to these statutory categories of patentable subject matter. These exceptions are limited to abstract ideas, laws of nature, and natural phenomena. Applicant respectfully submits that sending a message in a multimedia message service environment, where the message includes an electronic stamp whose validity is verified by a multimedia message service center, where the electronic stamp is an element associated with paying for sending the message, as recited in claim 1, is not an abstract idea, law of nature, or natural phenomenon. Instead, this is a new and useful process, in which payment for sending multimedia messages is established. Therefore, claims 1-5 are directed to statutory subject matter under 35 U.S.C. § 101.

Fourth, even if claim 1 falls within a judicial exemption, it would be directed to a practical application of a judicial exemption, and therefore would constitute patentable subject matter under 35 U.S.C. § 101, since, as noted in the Guidelines, if a claimed invention falls within a judicial exemption, it is nonetheless directed to statutory subject matter if it is directed to a practical application of that judicial exception. In particular, a claimed invention is directed

to a practical application if it transforms an article or physical object to a different state or thing, or otherwise produces a useful, concrete, and tangible result. The Guidelines state that the tangible result requirement only requires that a “process claim must set forth a practical application of that judicial exception to produce a real-world result.” The Guidelines further state that a patent is granted for “the discovery or invention of some practical method or means of producing a beneficial result or effect.” As discussed above, the payment for multimedia messages by using electronic stamps is a “tangible result” of the claimed invention

Accordingly, for at least these reasons, the Examiner has failed to establish a prima facie case of unpatentability under 35 U.S.C. § 101, thus Applicant respectfully requests that the rejection of claims 1-5 under 35 U.S.C. § 101 be reconsidered and withdrawn.

III. Prior Art Rejections

Independent claim 1 recites in part:

A multimedia message service wherein a message is sent in a multimedia message service environment comprising a multimedia message service center, wherein a sent Multimedia Messaging Service message includes an electronic stamp whose validity is verified by said multimedia message service center,

wherein the electronic stamp is an element associated with paying for sending the message, and includes a value of the stamp.

In the previous Amendment filed on May 29, 2008, Applicant submitted that there is no teaching or suggestion in Kuzma of “a multimedia message service wherein a message is sent in a multimedia message service environment comprising a multimedia message service center,

wherein a sent Multimedia Messaging Service message includes an electronic stamp whose validity is verified by said multimedia message service center”, as recited in claim 1

In response, the Examiner asserts:

Kuzma teaches an electronic stamp whose validity is verified by said multimedia message service center wherein said electronic stamp is an element associated with paying for sending the message and includes a value of the stamp (Kuzma, column 4 lines 35-45, stamp is placed on message with an appropriate value, column 5 lines 57-65, post office checks validity of stamp) by teaching a multimedia message center in the form of an electronic post office verifying the payment stamp.³

Applicant finds the Examiner’s position unclear. Kuzma teaches the transmission of electronic messages (column 2, lines 41-52). A stamp is affixed to the electronic message and the stamped, encrypted electronic message is placed in an output mailbox and transmitted to an addressee. Nowhere does Kuzma teach or suggest that the use of an electronic stamp in a multimedia messaging service environment comprising a multimedia message service center, wherein a sent multimedia messaging service message includes the electronic stamp, as required by the claims. Further, the Examiner does not address with any specificity how the claimed multimedia message service center and the claimed multimedia messaging service message read on the cited prior art.

³ Page 2 of the Office Action dated July 28, 2008.

Accordingly, Applicant respectfully submits that independent claim 1 should be allowable because the cited reference does not teach or suggest all of the features of the claim. Claims 2-5 should also be allowable at least by virtue of its dependency on independent claim 1.

Further, Mobile News does not cure the deficiencies of Kuzma, since Mobile News does not teach or suggest “a multimedia message service wherein a message is sent in a multimedia message service environment comprising a multimedia message service center, wherein a sent Multimedia Messaging Service message includes an electronic stamp whose validity is verified by said multimedia message service center, wherein the electronic stamp is an element associated with paying for sending the message, and includes a value of the stamp”, as recited in claim 1

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.111
U.S. Appln. No.: 10/800,670

Attorney Docket No.: Q80358

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Mark E. Wallerson/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Mark E. Wallerson
Registration No. 59,043

Date: October 16, 2008